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REMARKS

Claims 1-20, 22, 23, 25-39 and 41-43 are currently pending in the subject application and are presently under consideration. Claims 1, 22, 38, 39, 42 and 43 have been amended as shown at pp. 2-10 of the Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 1-20, 22, 23, 25-37, 39 and 41-43 Under 35 U.S.C. §102(e)**

Claims 1-20, 22, 23, 25-37, 39 and 41-43 stand rejected under 35 U.S.C. §102(e) as being anticipated by Tung *et al.* (US Pat. No. 5,859,979). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Tung *et al.* does not teach each and every element of applicant's invention as recited in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention relates to analyzing data associated with parties involved in a communication attempt to identify the optimal one or more communication modalities to use in establishing the communication between the parties. For instance, if an employee wanted to contact a coworker, the invention could analyze the coworker's current attention state and preferred modality of communication to select the appropriate communication modality to establish, such as e-mail, voicemail, instant messaging, or a future meeting. In particular, independent claim 1 (and similarly recited in independent claims 22, 39, 42 and 43) recites a *first communication data set associated with a first entity and a second communication data set associated with a second entity, where at least one of the first entity and the second entity is a human being, the communication manager identifying a subset of the one or more communication modalities based at least in part on analysis of the first and second*

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*communication data sets and the communication manager establishing a communication between the entities via at least one modality of the subset.*

Tung *et al.* does not teach or suggest the aforementioned novel aspects of applicant's invention as recited in the subject claims. The cited art discloses a method for negotiating communication between video conferencing systems based upon the capabilities of each video conferencing system. The system is attempting to establish communication between the video conferencing systems, the "entities", and employs data associated with the video conferencing systems to accomplish this goal. Tung *et al.* discloses a user interface that allows the user to resize video windows on the computer, however, this is not related to identifying or establishing communication modalities. Therefore, Tung *et al.* fails to teach or suggest a first communication data set associated with a first entity and a second communication data set associated with a second entity, where at least one of the first entity and the second entity is a human being, the communication manager identifying a subset of the one or more communication modalities based at least in part on analysis of the first and second communication data sets and the communication manager establishing a communication between the entities via at least one modality of the subset.

In view of at least the foregoing discussion, applicant's representative respectfully submits that Tung *et al.* fails to teach or suggest all limitations of applicant's invention as recited in independent claims 1 and 22, 39, 42 and 43 (and claims that respectfully depend there from), and thus fails to anticipate the subject claimed invention. Accordingly, this rejection should be withdrawn.

## II. Rejection of Claim 38 Under 35 U.S.C. §103(a)

Claim 38 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Tung *et al.* in view of Ulwick (US Pat. No. 5,963,910). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Tung *et al.* and Ulwick, alone or in combination, do not teach or suggest each and every limitation of applicant's claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See MPEP §706.02(j).* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

*Independent claim 38 recites determining one or more current expected utilities associated with a communication between the communicating parties based, at least in part, on current contactor data, current contactee data and current communication modality data, where the current contactee data comprises current state data and the current contactor data comprises current state data, where at least one of the communicating parties is a human being; determining one or more predicted expected utilities associated with a communication between the communicating parties.* As discussed above, Tung *et al.* fails to teach or suggest that one of the communicating parties for which data is evaluated for expected utility is a human being. Moreover, Ulwick fails to make up for this deficiency in Tung *et al.* Ulwick discloses a system for evaluating strategic business options. However is silent regarding options regarding communication between parties where one of those parties is a human being and employing data associated with that human being to compute a current and predicted expected utility of communication. Therefore, withdrawal of this rejection is respectfully requested.

09/809,142MS171139.01/MSFTP221US**CONCLUSION**

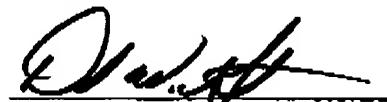
The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP221US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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